REMARKS

The above amendments and these remarks are responsive to the Office action dated May 17, 2004. Claims 34-48 are pending in the application. In the Office action, claim 34 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Drake et al. in view of Manning. In view of the amendments above, and the remarks below, applicant respectfully requests reconsideration of the application under 37 C.F.R. § 1.111 and allowance of the pending claims. New claims are supported through the specification and drawings. For example, support for new claims 39-48 are found on pages 18-19 of the specification as originally filed.

Rejections under 35 USC § 103

Regarding Claim 34, the Rejection applies a combination of Drake et al. in view of Manning. Drake et al. describes an invention "concerned with the provision of a system for creating and maintaining a presentation library which can be utilized as an educational database for selectively displaying live presentations captured in recorded form." Col. 1, lines 11-15, emphasis added. As such, it is clear that Drake et al. relates to a system for later review and playback of a previously recorded presentation. This is emphasized by repeated and consistent terminology, such as "playback" and "replay," used throughout the specification of Drake et al.

In applying Drake et al, the Rejection states:

> Drake et al. teaches a method, comprising: sampling a signal of an analog video to generate a plurality of frames of digitized image data, each frame having plurality of pixel values (See Fig. 1, items 16, 24, Col. 2, Lines 53-62); and substantially during sampling, repeatedly: selecting a sampled frame when values differ from pixel values of a previously captured frame (See Fig. 2, items 52, 54, 56, from Col. 3, Line 55 to Col. 4, Line 4), capturing selected sampled frame into a memory (See Fig. 2, item 70, Col. 4, Lines 38-39); transmitting captured frames to a display object (See Fig. 1, items 10,12, 80, Col. 5, Lines 7-13); and projecting transmitted captured frame by display object to replicate analog video (See Fig. 1, items 16, 18, Col. 2, Lines 50-51 and Col. 6, Lines 34-36).

Applicants disagree with several of the assertions cited above. As one example, Applicants have reviewed Cols. 5 and 6, but can find disclosure that the transmission of captured frames to a display object, and projection of transmitted captured frames by the display object to replicate analog video, occurs substantially during sampling, as stated in Claim 34. In particular, as noted above, Drake et al. only relates to later playback from a library. In other words, according to Drake et al., the playback occurs only after someone has selected a presentation matching a search, meaning that the presentation has already been stored and catalogued. See, for example, Col. 6, lines 33-36.

As another example, Drake shows a method that discards information if two video frames are "very different." In other words, as shown by Figure 2a,

steps 54 and 56, if the "next video frame is very different from current frame," then the frame is "discarded." This is directly contrary to the approach of claim 34, where differences in frames are used to identify which frames should be selected. As such, Drake et al. actually teaches away from the approach of claim 34.

Regarding Manning, the Rejection states:

> Manning teaches that after a key frame is established the next frame is compared to the key frame to determine whether the next frame is another key frame, capture the new key frame (See Fig. 2a-2c, items 42,50, in description See col.2, Lines 27-32); wherein the non-captured or (non-key) frames are skipped (See Fig. 2c, items 50,56,66, in description See Col. 6, Lines 3-5).

Again, Applicants disagree. For example, the process disclosed in Manning does not include eliminating frames that do not differ by a threshold amount. Instead, Manning reduces noise in digital video by using the pixel values of a key frame to replace the corresponding pixels of subsequent frames in an effort to salvage each frame and thereby perfect the quality of the video, as described at col. 4, lines 27-41. The Office action points out that Manning skips frames that are not key frames (col. 6, lines 3-5). This merely means that if the noise present in a frame is below a threshold amount, then the pixels in that frame are not altered. As stated in the abstract, "[t]he method proceeds recursively until all pixels in all frames are resolved by having their values

replaced by key frame values." (emphasis added). Thus, Manning actually teaches away from eliminating frames having pixel data that do not differ from that of other frames by a threshold amount.

As such, even assuming the references are combined, the combination fails to show all claimed limitations.

The combination is Improper

Furthermore, Applicants respectfully submit that the combination of references is improper. In order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or combine reference teachings. Such motivation cannot be based on a hindsight reconstruction of the Applicant's invention. Second, there must be a reasonable expectation of success. Third, the prior art reference(s) must teach or suggest all the claim limitations. (See, e.g. MPEP § 2143)

A suggestion, teaching or motivation to combine or modify references "must be clear and particular." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (citations omitted). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" of a suggestion, teaching or motivation to combine references. *Id.* (citation omitted). Furthermore, the Federal Circuit cautioned that combining prior art references without such a

teaching, suggestion or motivation, "simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." *Id.* (citation omitted). The law is "clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *Id.* (citation omitted).

Applying the law to the case at hand, Applicant submits that the claim rejections based on Manning and Drake et al. are improper because there is no teaching, suggestion, or motivation in any of the references to modify the structures in those references, as asserted in the Office action.

Manning fails to provide any suggestion to adapt its approach to a projection system, let alone a system that projects a digital replica of an analog image. Moreover, the cited references relate to substantially different aspects of video information. Manning relates to replacing pixel information to reduce noise, while Drake et al. relates to an automated presentation, storage, and playback system. There is no suggestion in any of the cited references to combine their teachings.

Thus, even if the presently claimed invention could be found by combining Manning and Drake et al., such a combination would only be based on an impermissible hindsight reconstruction. A combination based on hindsight reconstruction is improper and withdrawal of the rejection is requested.

New Claims 37-44

Applicants respectfully submit that these new claims distinguish the cited references and should be allowed.

Conclusion

Applicant believes that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicants respectfully request that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on October 18, 2004.

Lisa Holstein

Respectfully submitted,

KOLISCH HARTWELL, P.C.

B. Anna McCoy
Registration No. 46,077
Customer No. 23581
Attorney for Applicant
520 S.W. Yamhill Street, Suite 200
Portland, Oregon 97204
Telephone: (503) 224-6655
Facsimile: (503) 295-6679